



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,099	03/30/2004	Michael J. Sutherland	FS1-0005US	6569
29150 7590 11/12/2009 LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE, WA 99201				
EXAMINER ABDELSALAM, FATHI K				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
11/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,099

**Applicant(s)**

SUTHERLAND ET AL.

**Examiner**

Fathi Abdelsalam

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/29/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31, 33-54 and 56-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31, 33-54 and 56-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a final office action in response to communications received on 6/29/2009.

#### ***Response to Amendments***

2. The amendment of 6/29/2009 has been received and entered. Claims 32, 55 and 68 have been cancelled by applicant. Claims 1, 33, 58 and 67 have been amended. Claims 1-31, 33-54, and 56-67 are pending herein.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-31 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product)

to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-31 describes a method nominally tied, at best, to a computer system, wherein no functional tie or transformation takes place. Examiner recommends applicant to mention a "computer database," rather than just a database, since a "database with a storage medium" in of itself could simply be a blank piece of paper for recording information by hand.

5. Claims 33-54 and 58-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter) because claims 33-54 and 58-67 are directed to a "management module" and "computer device," respectively comprising configured "logic," which is basically, or appears to be, software *per se*, and therefore considered disembodied functional descriptive material. A computer software application *per se* does not define any structural and functional interrelationships between the computer application and other claimed elements of a computer which permit the computer application's functionality to be realized. Examiner

recommends applicant mention a processor implementing the logic in some way, shape, or form.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

7. Claims 1-31, 33-54, and 56-67 are rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, obvious under 35 U.S.C. 103(a) over, Tschiegg et al. (US PG Publication 20050192963), hereinafter referred to as "Tschiegg."

8. Regarding **Claims 1 and 33**:

Tschiegg discloses a method and recommendation management module for managing recommendations using a computer system, comprising:

receiving, and logic implemented by at least one computer device configured to receive, survey information from an individual serving a first role pertaining to an aspect

of an organizational entity, the survey information including at least one recommendation ("the graphics interface accommodates input of interactive recommendations" [0017]). See also ("The database may for example be a SQL database server. The database of one aspect responds to electronically received recommendations regarding a segment of risk management information to post the recommendations with the segment of risk management information" [0016]). See also ("the graphic data may include one or more graphical reports such as a fire protection, recommendation summary, loss prevention survey report delivery, loss prevention survey report schedule, risk quality benchmarking, risk quality rating, management programs, building construction, catastrophe, active recommendations, and completion status" [0013]);

storing, and logic configured to store, the survey information in a database associated with a storage medium ("In another aspect, the database responds to inputs by a user with authorized access, at a computer networked with the database, to securely store electronic documents with the risk management information associated with the user" [0015]);

receiving, and logic configured to receive, via a user interface, first recommendation information from an individual serving a second role, the first recommendation information being based on the survey information received from the individual serving the first role ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the

recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]);

storing, and logic configured to store, the recommendation information in a database associated with a storage medium (See Paragraph [0015]);

receiving, and logic configured to receive, via the user interface, second recommendation information from an individual serving a third role, the second recommendation information being based on the first information received from the individual serving the second role ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]);

storing, and logic configured to store, the second recommendation information in a database associated with a storage medium (See Paragraph [0015]); and

addressing said at least one recommendation based on the first and second recommendation information, the addressing of said at least one recommendation including initiating a response to said at least one recommendation information. ("The resulting data is particularly useful in providing recommendations to customers, and the system may also provide a reporting and tracking mechanism subject to one or both of recommendation fulfillment and recommendation rejection" [0029]).

9. Regarding **Claims 2 and 34**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein the individual serving the first role, the individual serving the second role, and the individual serving the third role are different individuals ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]).

10. Regarding **Claim 3**:

Tschiegg discloses the method according to claim 1, wherein the individual serving the first role is a field consultant who serves the role of inspecting the organizational entity to determine whether it satisfies a defined criterion ("Remotely located associates or network peers may be tasked to collect information at the customer's request, for example, when the associate inspects a customer's facilities" [0177]).

Moreover, the nature of the particular individual serving a first role, and the specific criterion defined, has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight.

11. Regarding **Claim 4**:

Tschiegg discloses the method according to claim 3, wherein the defined criterion pertains to safeguards against property loss within the organizational entity,



and said at least one recommendation pertains to a measure designed to reduce property loss ("users can manipulate recommendation cost benefit analysis information to reconcile the informational content of database 20 with actual events. This provides improved predictive accuracy by comparing, for example, total loss estimates before damage occurs versus actual total loss after damage occurs; property damage loss estimates before damage occurs versus actual property damage loss after damage occur" [0172]). See also ("Risk reduction=[(property loss before+business interruption loss before)-(property loss after +business interruption loss after)-Estimated Cost to Complete]" [0173])

12. Regarding **Claim 5**:

Tschiegg discloses the method according to claim 1, wherein the individual serving the second role is a risk manager who serves the role of evaluating and addressing risk-related issues associated with the organizational entity ("When system 10 is used to provide a recommendation, users are available to assess the recommendation by viewing the impact upon the facility's overall risk quality rating" [0175]).

Moreover, the nature of the particular individual serving a second role, and the specific issue evaluated, has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight.

13. Regarding **Claim 6**:

Tschiegg discloses the method according to claim 1, wherein the individual serving the second role is a facility manager who serves the role of coordinating the implementation of risk-reduction measures within a facility ("At exit conference 2504, the field associate consults with facility management to configure new commitments and recommendations resulting from survey 2502" [0150]).

Moreover, the nature of the particular individual serving a second role, and the specific measure coordinated, has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight.

14. Regarding **Claim 7**:

Tschiegg discloses the method according to claim 1, wherein the individual serving the third role is a risk manager who serves the role of evaluating and addressing risk-related issues associated with the organizational entity ("When system 10 is used to provide a recommendation, users are available to asses the recommendation by viewing the impact upon the facility's overall risk quality rating" [0175]).

Moreover, the nature of the particular individual serving a third role, and the specific issue evaluated, has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight.

15. Regarding **Claim 8**:

Tschiegg discloses the method according to claim 1, wherein the individual serving the third role is a facility manager who serves the role of coordinating the

implementation of risk-reduction measures within a facility ("At exit conference 2504, the field associate consults with facility management to configure new commitments and recommendations resulting from survey 2502" [0150]).

Moreover, the nature of the particular individual serving a third role, and the specific measure coordinated, has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight.

16. Regarding **Claim 9**:

Tschiegg discloses the method according to claim 1, wherein the organizational entity is a business having multiple facilities ("graphs to compare a company's facilities to outstanding recommendations associated with risk management information 12" [0098]). See also ("elements across facilities" [0166]).

17. Regarding **Claims 10 and 35**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein the receiving of the first recommendation information from the individual serving the second role and the receiving of second recommendation information from the individual serving the third role comprises sequentially providing a recommendation response report to the individual serving the second role and then to the individual serving the third role via the user interface, wherein the recommendation response report includes input fields for receiving the first recommendation information from the individual serving the second

role and from the second recommendation information from the individual serving the third role ("All reports 2904, 2910, 2914, 2918, 2922 may be interactively edited for adjustment or modification, as deemed desirable by the user" [0162]). See also ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]). See also ("FIGS. 6-24 collectively illustrate a flow chart for computer process operations that operate on the data elements shown in FIGS. 5A-5H with the assistance of user input and system output provided by graphic display screens and system components suitable for use and operation with system of FIG. 1" [0045]).

18. Regarding **Claims 11 and 36**:

Tschiegg discloses the method according to claim 10, and the respective management module according to claim 35, wherein the user recommendation report includes a first section for receiving the first recommendation information from the individual serving the second role and a second section for receiving the second recommendation information from the individual serving the second role ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]).

See also ("The reporting engine may summarize the risk management information, for example, by reporting from the database using user-defined data

filtration parameters, calculating statistics, producing counts of data fields, adding loss estimate data to represent a total exposure value, or plotting data points that associate color codes with levels of risk exposure." [0006]), ("a segment of risk management information to post the recommendations with the segment of risk management information" [0016]) and Paragraph [0013] -- the reports can be sectioned off.

19. Regarding **Claims 12 and 37**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein the receiving of first recommendation information from the individual serving the second role comprises receiving at least one of:

intent information which conveys instructions of the individual serving the second role ("produces a corresponding pop-up report referred to as a "tool tip," which explains the value to the user and how it may be used or applied according to expert instructions" [0164]); and comment information provided by the individual serving the second role ("provides for appending user-generated comments to one or more segments of the risk management information" [0019]).

Furthermore, the specific data-information received is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim

limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85,217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data relating to the intent and comment information adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data.

20. Regarding **Claims 13 and 38**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein the receiving of second recommendation information from the individual serving the third role comprises receiving at least one of:

intent information which conveys the response of the individual serving the third role to instructions of the individual serving the second role ("produces a corresponding pop-up report referred to as a "tool tip," which explains the value to the user and how it may be used or applied according to expert instructions" [0164]); and comment information provided by the individual serving the third role ("provides for appending user-generated comments to one or more segments of the risk management information" [0019]). See also at least: ("A graphics interface generates graphic data of the risk management information in response to the authorized access. Users interact with the system in an I/O context via the graphics interface to access the risk management information" [0006])

Furthermore, the specific data-information received is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85,217

USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data relating to the intent and comment information adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data.

21. Regarding **Claims 14 and 39**:

Tsiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including receiving a target date associated with the implementation of said at least one recommendation ("users at



computers 14 may set target dates, adjust status, and identify intent so as to better track the recommendation's actual progress towards completion" [0112]).

22. Regarding **Claims 15 and 40**:

Tschiegg discloses the method according to claim 14, and the respective management module according to claim 39, further including receiving status information pertaining to the target date ("users at computers 14 may set target dates, adjust status, and identify intent so as to better track the recommendation's actual progress towards completion" [0112]).

23. Regarding **Claims 16 and 41**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein the user interface includes at least one field having a visual attribute that conveys a level of urgency associated with said at least one field ("plotting data points that associate color codes with levels of risk exposure" [0006])

24. Regarding **Claims 17 and 42**:

Tschiegg discloses the method according to claim 16, and the respective management module according to claim 41, wherein said at least one field pertains to a target date field, and the visual attribute is color ("plotting data points that associate color codes with levels of risk exposure" [0006])

25. Regarding **Claims 18 and 43**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including sending a notification from the individual serving the second role to at least the individual serving the third role after the first recommendation information is received from the individual serving the second role ("e-mail notification engine cooperate to automatically generate an e-mail when new information is posted to the risk management database...[t]he email is addressed to a user at an access terminal that has the appropriate authorizations" [0011]). See also ("An email notification server and/or application provide for communicating email to an authorized user of the one segment to notify the authorized user of the augmented information" [0024]).

Alternatively, employing a notification as a means of a reminder is common practice throughout many industries (e.g., credit card services, such as Visa Card providers, often employ email-reminder notifications prior to the billing due date), and subsequently, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

26. Regarding **Claims 19 and 44**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including sending a reminder notification to at least the individual serving the third role if the individual serving the

third role fails to enter the second recommendation information within a predetermined period of time ("The user may also change the frequency of e-mail notification at their own discretion via the same screen" [0011]).

Alternatively, employing a notification as a means of a reminder is common practice throughout many industries (e.g., credit card services, such as Visa Card providers, often employ email-reminder notifications prior to the billing due date), and subsequently, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

**27. Regarding Claims 20 and 45:**

Tschiegg discloses the method according to claim 19, and the respective management module according to claim 44, wherein the predetermined period of time is measured with respect to a time when the individual serving the second role entered the recommendation information ("Email may also be generated periodically to inform the user of interim updates" [0011]). See also ("System 10 may also generate similar email notifications on a periodic basis, e.g., monthly, weekly or daily, to summarize newly posted information within a segment" [0067]).

**28. Regarding Claims 21 and 46:**

Tschiegg discloses the method according to claim 19, and the respective management module according to claim 44, wherein the predetermined period of time is measured with respect to a specified target date pertaining to the implementation of

said at least **one** recommendation ("Email may also be generated periodically to inform the user of interim updates" [0011]). See also ("System 10 may also generate similar email notifications on a periodic basis, e.g., monthly, weekly or daily, to summarize newly posted information within a segment" [0067]). See also ("users at computers 14 may set target dates" [0112]).

29. Regarding **Claims 22 and 47**:

Tschiegg discloses the method according to claim 19, and the respective management module according to claim 44, further including sending another reminder notification if the individual serving the third role fails to respond to the first-mentioned reminder notification, the other reminder notification conveying greater urgency compared to the first-mentioned reminder notification ("Email may also be generated periodically to inform the user of interim updates" [0011]). See also ("System 10 may also generate similar email notifications on a periodic basis, e.g., monthly, weekly or daily, to summarize newly posted information within a segment" [0067]).

Alternatively, employing a notification as a means of a reminder is common practice throughout many industries (e.g., credit card services, such as Visa Card providers, often employ email-reminder notifications prior to the billing due date; wherein if the customer is delinquent, a follow-up notification reminder is sent expressing greater urgency), and subsequently, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

30. Regarding **Claims 23 and 48**:

Tschiegg discloses the method according to claim 19, and the respective management module according to claim 44, further including customizing at least one of: a timing at which the reminder notification is to be transmitted ("System 10 may also generate similar email notifications on a periodic basis, e.g., monthly, weekly or daily, to summarize newly posted information within a segment" [0067]); an identity of at least one recipient who is to receive the reminder notification ("The email is addressed to a user at an access terminal that has the appropriate authorizations" [0011]); information content of the reminder notification; and a style of the reminder notification.

31. Regarding **Claims 24 and 25**:

Tschiegg discloses the method according to claim 1, wherein, in a top-down mode of process flow, the individual serving the second role serves an overseeing role with respect to the individual serving the third role; and wherein, in a bottom-up mode of process flow, the individual serving the third role serves an overseeing role with respect to the individual serving the second role ("FIG. 25 shows a flowchart 2500 illustrating logistical process operations for obtaining data and system elements for the risk management interface system 10 (see also FIG. 1). At survey 2502, a remote field associate (e.g., an engineer) collects information to complete a risk evaluation from a customer's physical facility. By way of example, the associate may interact with system 10 via a terminal 24 (shown in FIG. 1). At exit conference 2504, the field associate

consults with facility management to configure new commitments and recommendations resulting from survey 2502" [0150]).

Alternatively, employing a chain of command structure in a business or governmental environment, wherein a subordinate reports to a leader/overseer is common practice, regardless of who, specifically, is assigned the leader role, and therefore, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

32. Regarding **Claims 26 and 49**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, wherein, in a top-down mode of process flow, the individual serving the second role serves an overseeing role with respect to the individual serving the third role, and, in a bottom-up mode of process flow, the individual serving the third role serves an overseeing role with respect to the individual serving the second role, and, in a no-flow mode of process flow, either the individual serving the second role or the individual serving the third role can enter recommendation information first, and the method further includes allowing a user to define whether the method is to operate in the top-down mode or the bottom-up mode or a no-flow mode.

Alternatively, employing a chain of command structure in a business or governmental environment, wherein a subordinate reports to a leader/overseer, or also where business is conducted on a "same-level" team basis in a ad-hoc manner (herein termed "no-flow mode"), is common practice, regardless of who, specifically, is assigned

the leader role, and therefore, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

33. Regarding **Claims 27 and 50**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including providing a listing that identifies a historical sequence of information entered by the individual serving the first role, the individual serving the second role, and the individual serving the third role ("Via comments screen 2526, a user may read an archived history of comments made relative to specific recommendations (or sub-recommendations)... summary data and/or comment history (collectively the "data sets" 2528). Changes to specific data sets 2528, namely the comments, status, intent, target dates, etc., are ported directly back to database 2512 for update and future access through messenger 2510" [0153]). See also ("A system of claim 28, where the secure database contains a historical archive of risk management features that have been changed through use of the means for reconciling" [Claim 29]).

34. Regarding **Claims 28 and 51**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including filtering received survey information and recommendation information based on at least one selected criterion

("In yet another aspect, the graphics interface provides one or more filter functions to manipulate the risk management information for display of graphic data at a computer networked with the graphics interface" [0012]).

35. Regarding **Claims 29 and 52**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including sorting received survey information and recommendation information based on at least one selected criterion ("Further aspects of the system may include a robust reporting capability that can be used to sort and filter relevant risk management data according to user-specified parameters" [0027]).

36. Regarding **Claims 30 and 53**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including printing received survey information and recommendation information in a selected report format ("A method of claim 50, further comprising a step of exporting the risk management information in a computer readable form" [Claim 75]). See also ("In another example, the reporting engine can provide a location snapshot report that includes summary information for a particular location" [0028])



Alternatively, printing items from a printer is common practice, and therefore, one of ordinary skill in the art at the time of applicant's claimed invention would have found this use obvious to have included in the method described above.

37. Regarding **Claims 31 and 54**:

Tschiegg discloses the method according to claim 1, and the respective management module according to claim 33, further including exporting received survey information and recommendation information into a selected export file format ("A method of claim 50, further comprising a step of exporting the risk management information in a computer readable form" [Claim 75]). See also ("Data may be exported from the system, for example, as a computer readable form attached to an email. In some embodiments, exportation of data launches a spreadsheet or other analysis program that permits the user to manipulate the data outside the confines of the system" [0041]).

38. Regarding **Claim 56**:

Claim 56 recites substantially similar limitations to claims 1 and 33 and is therefore rejected using the same art and rationale set forth above.

Tschiegg further discloses:

a plurality of computer devices available to an individual serving a first role, an individual serving a second role, and an individual serving a third role ("One or more access computers coupled in network with the graphics interface" [0010]);

processing functionality communicatively coupled to the plurality of computer devices via a network ("In another aspect, one or more workflow process terminals connect in network with the database to provide updates to the risk management information. The terminals may for example include a computer, facsimile, telephone and scanner" [0007]);

wherein the processing functionality includes:

a database storage ("In another aspect, the database responds to inputs by a user with authorized access, at a computer networked with the database, to securely store electronic documents with the risk management information associated with the user" [0015]).

39. Regarding **Claim 57**:

Claim 57 recites substantially similar limitations to claim 2 and is therefore rejected using the same art and rational set forth above.

40. Regarding **Claim 58**:

Claim 58 recites substantially similar limitations to claims 1 and 33 and is therefore rejected using the same art and rational set forth above.

41. Regarding **Claim 57**:

Claims 59, 60, 62, 63, 64, 65, 66, and 67 recite substantially similar limitations to claims 2, 10, 12, 14, 15, 16, 17, and 27 and is therefore rejected using the same art and rational set forth above.

42. Regarding **Claim 61**:

Tschiegg discloses the computer device according to claim 58, wherein the first section includes input fields for receiving at least one of:

intent information which conveys instructions of the individual serving the first role ("produces a corresponding pop-up report referred to as a "tool tip," which explains the value to the user and how it may be used or applied according to expert instructions" [0164]); and comment information provided by the individual serving the first role ("provides for appending user-generated comments to one or more segments of the risk management information" [0019]).

Furthermore, the specific data-information received is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85,217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981).

However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data relating to the intent and comment information adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data.

### ***Response to Arguments***

43. Applicant's arguments filed 6/29/2009 have been fully considered, but they are not persuasive.

44. Regarding the rejection of claims under 35 U.S.C. §102 and §103:

With regard to Applicant's assertion that the rejection is improper (in relation to the §103 rejected elements) due to the instant application and application no. 10/411,912 (Tshiegg) being commonly owned by ERC-IP, LLC, Examiner invites applicant to provide evidence that the claimed invention was commonly owned by the same person or subject to an obligation of assignment to the same person *at the time the claimed invention was made*. Emphasis added to underscore the criterion of the requested evidence. Although the filing date of the prior application is known, this doesn't say anything about when either was made. Upon receipt of requested evidence, Examiner will promptly rescind the rejection under 35 U.S.C. §103. See MPEP § 706[R-5](c)(4).

As regards applicant's assertion that Tshiegg neither discloses nor suggests the "receiving" acts recited in claims 1, 33, 56, and 58, respectively, Examiner respectfully disagrees. See ("In another aspect, recommendations may be shared between users through the interface and over the network. By way of example, the recommendations may be shared based upon access and authority levels of accounts, divisions, locations, or individuals" [0021]); also reiterated: ("the graphics interface accommodates input of interactive recommendations" [0017]). Upon initial receipt of the survey information (information including the recommendation), users further receive recommendations via sharing the information amongst each other based on access and authority level (i.e., roles).

In regard to applicant's confusion over the storing mechanism of Tshiegg, please see ("In another aspect, the database responds to inputs by a user with

authorized access, at a computer networked with the database, to securely store electronic documents with the risk management information associated with the user" [0015]); thereby readily storing the information in the database.

### ***Conclusion***

45. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fathi Abdelsalam whose telephone number is (571) 270-3517. The examiner can normally be reached on Monday to Thursday 8:00-5:00pm ET.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A./  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689